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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/774,934
Filing Date: February 09, 2004
Appellant(s): PARKS ET AL.

Peter Kraguljac
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/03/2008 appealing from the Office action mailed 1/24/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner: The rejection of claim 26 under 35 U.S.C. 101.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

5185860	Wu	02-1993
20020049809	Moetteli	05-2002
20020103888	Janz et al.	08-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Roy et al. (US 2002/0062366), hereafter Roy.

Regarding **claims 1-9**, Roy discloses:

1. A client-side auto-rediscovery system, comprising:

a data store configured to store a pairing data that relates a service requesting networked device and a service providing networked device; and
(Fig. 7 contains data indicating pairing data between printer names and the network addresses that a requesting device can use to reach them)

a logic configured to determine whether the pairing data should be updated and to selectively update the pairing data. (Fig. 7 is generated upon user request, [0009])

2. The system of claim 1, where the data store comprises one or more of, a file, a memory, and a register. (Fig. 7 is both a HTML file, which also must be stored on a memory)

3. The system of claim 2, where the pairing data comprises one or more of, an IP address, a unique hardware identifier, a unique software identifier, a virtual identifier, and a dynamic identifier. (Fig. 7 discloses IP addresses and printer names)

4. The system of claim 3, where the unique hardware identifier comprises one or more of, a media access control (MAC) address, a globally unique identifier (GUID), an object identifier (OID), and an IP address. (Fig. 7 discloses IP addresses and printer names)

5. The system of claim 4, where the service requesting networked device comprises one of, a computer, a printer, a scanner, and a server. (Fig. 1 discloses HTTP client 15, which is a computer)

6. The system of claim 5, where the service providing networked device comprises one of, a computer, a printer, a scanner, and a server. (Fig. 7 discloses printers)

7. The system of claim 6, where the logic is further configured to generate a uni-cast simple network management protocol (SNMP) GET message to be delivered from the service requesting networked device to the service providing networked device to request a binding data that facilitates determining whether to update the pairing data. ([0041] discloses sending uni-cast SNMP get messages)

3. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Roy et al. (US 2002/0062366), hereafter Roy.

Regarding **claim 12**, Roy discloses:

A client-side auto-rediscovery system, comprising: means for storing a pairing data that relates a service requesting networked device and a service providing networked device; means for doing weak discovery between the service requesting networked device and the service providing networked device; and means for selectively performing automatic strong discovery to rediscover the service providing networked device based on the weak discovery and selectively updating the pairing data based on the strong discovery. (Abstract. First a UDP based request is broadcasted to the network to receive device information (i.e. a weak discovery), then in the end any remaining nodes are updated using specific SNMP requests. (i.e. a selectively strong discovery))

4. Claims 13,15-29, and 31-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Roy.

Regarding **claims 13 and 15-25**, Roy discloses:

A client-side auto-rediscovery method, comprising: determining whether to perform a process that facilitates relating a first networked device and a second networked device; and performing the process by: selectively requesting from one or more networked devices a binding data that facilitates uniquely identifying a networked device; receiving, in response to requesting the binding data, a message that includes the binding data; and selectively updating a pairing data

that relates the first networked device and the second networked device based, at least in part, on the binding data. ([0025] and [0026] disclose selectively requesting, receiving a response with data, and updating a pairing data with the data received.)

15. The method of claim 13, where determining whether to perform the process is performed when the first networked device requests a service from the second networked device. (Fig. 1, a request from HTTP client 15 to management station 5 causes the process to be performed)

16. The method of claim 13, where determining whether to perform the process includes requesting the binding data from the second networked device via a uni-cast message. ([0041] discloses using a unicast SNMP message)

17. The method of claim 16, where the uni-cast message comprises an SNMP GET request. ([0041] discloses using a unicast SNMP message)

18. The method of claim 17, where the binding data comprises one or more of, a MAC address, an OID, a GUID, an IP address, and a virtual name. ([0026] discloses extracting IP address information from the broadcast response. [0041] discloses retrieving the device name (i.e. a virtual name) from the unicast SNMP request.)

19. The method of claim 13, where the binding data is requested in one or more of, a broadcast message, a multicast message, and a uni-cast message. ([0025

discloses using a broadcast SNMP message, [0041] discloses using a unicast SNMP message)

20. The method of claim 19, where one or more of, the broadcast message, the multicast message, and the uni-cast message comprise one or more of, an SNMP GET request, and an SLP request. ([0025 discloses using a broadcast SNMP message, [0041] discloses using a unicast SNMP message)

21. The method of claim 20, where the binding data comprises one or more of a MAC address, an OID, a GUID, an IP address, and a virtual name. ([0026] discloses extracting IP address information from the broadcast response. [0041] discloses retrieving the device name (i.e. a virtual name) from the unicast SNMP request.)

22. The method of claim 21, where the binding data is received in a second unicast message. ([0025 discloses data being returned in an SNMP response, [0041] discloses the data being returned in a SNMP response)

23. The method of claim 22, where the second uni-cast message comprises one or more of, an SNMP GET RESPONSE message, and an SLP message. ([0025 discloses data being returned in an SNMP response, [0041] discloses the data being returned in a SNMP response)

24. The method of claim 13, where the pairing data includes one or more of, an IP address, a MAC address, an OID, a GUID, and a virtual name. ([0026] discloses extracting IP address information from the broadcast response. [0041]

discloses retrieving the device name (i.e. a virtual name) from the unicast SNMP request.)

25. The method of claim 13, where the process is performed by a device driver.
(Fig. 1, Device Discovery Task 10 drives the management station to perform the process)

Regarding **claims 26-29**, Roy discloses:

The limitations of claims 26-29 are substantially the same as those recited in claim 13 except for the existence of a computer readable medium. A computer readable medium is clearly implied by management station 5 and HTTP client 15 in figure 1.

Regarding **claims 31-36**, Roy discloses:

The limitations of claim 31 are substantially the same as those recited in claim 13 except that they call for “re-discovering” a second connection and “re-associating” the stored connection. Roy discloses these additional limitations because the devices will be discovered and associated again when the HTTP client makes additional requests to the management device 5.

32. The method of claim 31, where discovering the first connection comprises sending one or more of, a broadcast message and a multicast message by one or more of, an SNMP message and an SLP message to one or more service providing networked devices. ([0025 discloses using a broadcast SNMP message)

33. The method of claim 32, where client-side associating the stored connection comprises storing one or more of, a unique hardware identifier, a unique software

identifier, a virtual identifier, a dynamic identifier, and a uni-cast IP address associated with the service providing networked device. ([0026] discloses extracting IP address information from the broadcast response)

34. The method of claim 33, where validating the stored connection to the service providing networked device comprises sending a uni-cast SNMP GET message to the service providing networked device. ([0041] discloses using a unicast SNMP message)

35. The method of claim 34, where selectively re-discovering the second connection comprises sending one or more of, a broadcast message and a multicast message by one or more of, an SNMP message and an SLP message to one or more service providing networked devices. ([0025 discloses using a broadcast SNMP message)

36. The method of claim 35, where client-side re-associating the stored connection comprises updating a pairing table. (Fig. 7 would be re-associated based off of the results of a subsequent request from the HTTP client)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roy as applied to claim 13 above, and further in view of Wu (US 5185860).

Roy discloses all the limitations of claim 14 except for a periodic determination of when to perform the address updating process.

The general concept of updating address tables periodically is well known in the art as taught by Wu. (Col. 9, the paragraph describing Fig. 16 discloses waiting for a set period, then re-querying for updated address data.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Roy with the general concept of updating address tables periodically as taught by Wu in order to decrease the amount of network traffic caused by a request.

7. Claims 10 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Roy.

Regarding claims 10 and 30, Wu discloses:

A data store configured to store IP and MAC addresses associated with devices on a network. (Col. 8 lines 56-59 discloses a node list which stores the physical and IP addresses for devices on the network (i.e. nodes.)

A second logic configured to produce a multicast (i.e. broadcast) snmp get message and update the data store based upon that information. (Col. 6 lines 33-46 discuss broadcasting SNMP get messages, Col. 9 lines 12-44 discuss updating the data store)

A first unicast logic to update network connectivity information about the nodes. (Col. 7 line 16 - Col. 8 line 5)

Wu discloses all the limitations of claims 10 and 30 except that the first logic used is SNMP.

Roy discloses a system that uses both broadcast (multicast) and unicast SNMP messages to discover device information about nodes in the network.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Wu and Roy in order to eliminate the need for extra network protocols to be used, thus making the system simpler.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu and Roy as applied to claim 10 above, and further in view of Moetteli (US 2002/0049809).

Wu and Roy disclose all the limitations of claim 10 except that the data store is an XML file. Roy, however, does disclose the data store being a HTML file.

Moetteli teaches that XML is a substitute for HMTL.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wu and Roy with the teaching that XML is a substitute for XML as taught by Moetteli in order to make the data store display more customizable.

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy as applied to claims 1-7 above, and further in view of Janz et al. (US 20020103888), hereafter Janz.

Regarding claims 8-9, Roy discloses

8. The system of claim 7, where the logic is further configured to selectively generate a multicast SNMP GET message to be delivered to a plurality of service

providing networked devices to request a binding data that facilitates updating the pairing data. ([0025] discloses sending SNMP broadcast GET messages)

9. The system of claim 8, where the binding data comprises one or more of, a MAC address, a GUID, an OID, an IP address, and a virtual name. ([0026] discloses extracting IP address information from the broadcast response. [0041] discloses retrieving the device name (i.e. a virtual name) from the unicast SNMP request.)

Roy does not disclose that the multicast get message is sent after a desired response is not received from a unicast get message.

The general concept of updating incorrect data discovered through a unicast message using a multicast message is well known in the art as taught by Janz. (See at least the abstract, which teaches "performing a SNMP get call to the recorded network address ... responsive to a mismatch ... The current network address is resolved by ... sending a network multicast request for hardware addresses")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Roy and the general concept of updating incorrect data discovered through a unicast message using a multicast message as taught by Janz in order to make sure that the most up to date information is in memory.

(10) Response to Argument

I. Appellant argues that the rejection of claim 26 under 35 U.S.C. 101 should be withdrawn because of the cancellation of 'carrier waves', 'transmission media', and 'signals' from the specification.

The Examiner has withdrawn the rejection under 35 U.S.C. 101 because Appellant has removed carrier waves and other forms of energy as part of the definition of "computer readable medium", and has argued that this deletion eliminates signals and other forms of energy from the scope of "computer readable medium" in claims 26, 27, and 29, thus the rejection is overcome.

II. Regarding the rejection of claim 1 under 35 U.S.C. 102(b), Appellant argues that Roy does not include 'logic to determine whether pairing data should be updated' because Roy discloses something manual, and Appellant believes that claim 1 includes something done automatically. (Brief, pages 13-14)

As stated in the rejection of record, the system of Roy does use logic to determine when to update pairing data. The logic consists of detecting when a user desires an update of the data. The logic then proceeds with the update.

Appellant's arguments that their system may be triggered by other factors than user input do not carry weight, as these limitations are not found in the instant claims.

Appellant further argues that the preamble stating that 'client-side auto-discovery' should be given patentable weight, although this is not generally the case (Brief, pg 14).

The Examiner disagrees, the preamble "client-side auto-discovery" does not limit the claim by giving 'life and meaning' to the claim. This broad preamble does not specify what steps are on the client-side, or even, what side -is- the client side, further, it does not specify what steps are 'automatic'. Giving patentable weight to the preamble would render the claim indefinite since one of ordinary skill in the art could not determine which steps are 'automatic' and what steps are not.

Further, -even if- the preamble were given patentable weight, the automation of a previously known manual process is not patentable. (See MPEP 2144.04 III. In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958))

For these reasons, the rejection of claims 1-7 under 35 U.S.C. 102(b) in view of Roy should be maintained.

III. Regarding the rejection of claim 12 under 35 U.S.C. 102(b), Appellant argues that "Roy uses manually initiated weak discovery ... then uses strong discovery to fill in the missing information." Appellant further argues that Roy does nothing concerning updating pairing data. Appellant further argues that Roy is not 'automatic'. (Brief pp 15-16)

The Examiner has refuted Appellant's arguments regarding Roy being 'automatic' for Claim 1 above, and, for the sake of brevity, the Board is respectfully referred to the above.

The Examiner disagrees that Roy does nothing concerning pairing. The Examiner notes Figure 7 of Roy which contains data indicating pairing data between printer names and the network addresses that a requesting device can use to reach them.

Regarding Appellant's arguments using the phrases 'strong discovery' and 'weak discovery' the Examiner notes that the "definitions" used by Appellant in his specification are not definitions at all, but merely examples of what strong and weak discovery -may- include. Further, Appellant refers to Claim 10 for 'limiting' definitions of strong and weak discovery, however, Claim 10 does not use the terms strong and weak

discovery, but specifically set forth a specific action using an SNMP GET request. Thus the Examiner has interpreted the terms 'strong discovery' and 'weak discovery' with the broadest reasonable interpretation. Appellant has had an opportunity to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP 2111.

For these reasons, the rejection of claim 12 under 35 U.S.C. 102(b) in view of Roy should be maintained.

IV. Regarding Claim 13, Appellant has not provided any other substantive arguments other than those refuted for claims 1 and 12 above, and, for the sake of brevity, the Board is respectfully referred to the above. (Brief pp. 16-17) For these reasons, the rejection of claims 13 and 15-25 under 35 U.S.C. 102(b) in view of Roy should be maintained.

V. Regarding Claim 26, Appellant has not provided any other substantive arguments other than those refuted for claims 1 and 12 above, and, for the sake of brevity, the Board is respectfully referred to the above. (Brief pp. 17-18) For these reasons, the rejection of claims 26 and 27-29 under 35 U.S.C. 102(b) in view of Roy should be maintained.

VI. Regarding Claim 31, Appellant argues that Roy does not disclose "automatic rediscovery initiated when a service requesting device makes a request from a service

providing device.” The Examiner disagrees, for even using Appellant’s characterization of Roy as ‘user-initiated’, a device must receive the user’s request for rediscovery, and provide that request to the re-discovery device. (for example, a user must use some form of input device to interface with the computer, (a mouse, keyboard, voice input device, etc) this device is the ‘service requesting device’. The service providing device would be the ‘management device’ as cited by Appellant on page 18 of the brief.

Appellant further argues on page 19 that “this claim describes checking to see whether the stored data is correct when requests are made. If the data is not correct, then it can be corrected.” This is not found in claim 31. it is found that a stored connection is validated, and that no steps of the method are related to that 'validation' that takes place.

Appellant also alleges on page 19 that claim 31 includes the limitation that 'discovering and reconnecting to previously known devices on its own, without a user-initiated request to do so' is indeed found in claim 31. The Examiner disagrees, while, rediscovering and reconnecting to previously known devices is found in the claim as cited by Applicant, there is no requirement that this is done without a user-initiated request.

The Examiner notes that many of the arguments made in pages 18-19 regarding claim 31 are similar to arguments made regarding claims 1 and 12, and, for the sake of brevity, the Board is respectfully referred to the above reasons.

For these reasons, the rejection of claims 31 and 32-36 under 35 U.S.C. 102(b) should be maintained.

VII. Regarding claim 10, Appellant repeats the arguments made against claims 1 and 12 regarding the assertion of an 'automatic' feature of claim 10 (brief pp 20-21), and for the sake of brevity, the Board is respectfully referred to the above reasons.

Appellant additionally argues that the combination of Roy and Wu does not teach all of the logic is to be located in the requesting device. The only limitation in claim 10 defining a "requesting device" is that it is provided services by the service providing networked device. For completeness, the Examiner points out Figure 1 of Roy, the management station 5 contains the data store, first and second logic, as pointed out in the rejections above.

For these reasons, the rejection of claims 10-11 under 35 U.S.C. 103(a) should be maintained.

VIII. Regarding claim 30, Appellant argues that 'the entire method is being performed for the first networked device'. (brief pg 22) While it is true that claim 30 has the limitations of "determining on a per request basis whether to perform a process on behalf of a first networked device". The Examiner notes that there is no limitation in the claim that prohibits the first networked device from performing the process on behalf of itself, indeed, this is the interpretation the Examiner uses to map the claim to the system of Roy. Further, Appellant argues that the determination in Roy and Wu does not take place on a 'per request' basis. The Examiner disagrees, as the determination will occur every time a request is made by a user in Roy.

Arguments regarding the weight of the preamble were previously refuted in the discussion of claim 1 above, and for brevity, the Board is respectfully referred to the

above reasons. One of ordinary skill in the art would not recognize what steps would be performed by what device by the limitation 'client-side' in the preamble of the claim.

For these reasons, the rejection of claim 30 under 35 U.S.C. 103(a) should be maintained.

IX. Throughout the Brief, Appellant has characterized Roy and Wu as containing "strong discovery" and "weak discovery". The Examiner disagrees with any of these characterizations, as they only appear in the text of claim 12, and thus are irrelevant to the rejections pending for the other claims. As stated above, Appellant has not defined these terms in his specification explicitly, rather only providing "examples" of them. Further, Appellant has had an opportunity to amend the claimed subject matter, and has failed to modify the claim language to further define "strong discovery" and "weak discovery" in the claims, thus showing that these terms are to be given the broadest reasonable interpretation by the examiner.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/MEK/ 8/8/2008

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2154

Conferees:

Application/Control Number: 10/774,934
Art Unit: 2154

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